



CIP-1641

PATENT
Attorney Docket No. 202406

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 20 2001

In re Application Of:

Nie et al.

Serial No. 09/405,653

Group Art Unit: 1641 TECH CENTER 1600/2900

Examiner: C. Chin

Filed: September 24, 1999

For: WATER-SOLUBLE LUMINESCENT QUANTUM DOTS
AND BIOMOLECULAR CONJUGATES THEREOF
AND RELATED COMPOSITIONS AND METHODS
OF USE THEREOF

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

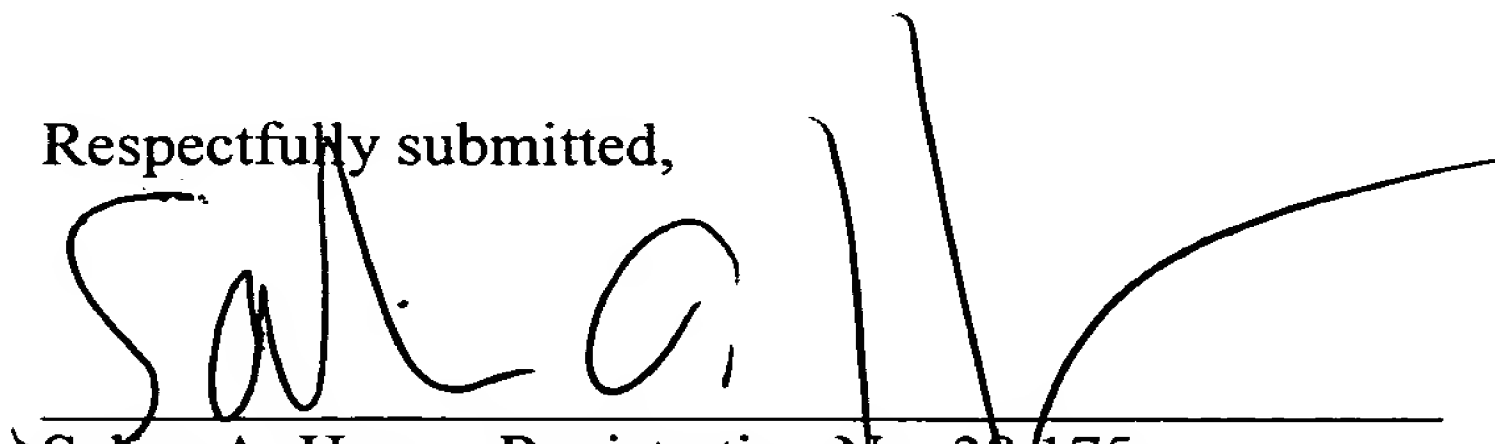
Dear Sir:

In response to the Office Action dated July 31, 2001, applicants enclose herewith a copy of the "Response to Restriction Requirement" previously submitted on May 10, 2001, in connection with the above-identified patent application. Also enclosed is a copy of the postcard submitted by applicants with the "Response to Restriction Requirement." Notably, the postcard has been stamped by the U.S. Patent and Trademark Office, thereby evidencing applicants' proper submission of all 4 pages of the "Response to Restriction Requirement" at that time.

This document is being submitted by facsimile, with a confirmation copy via First Class mail, to expedite prosecution of the application. The application is believed to be in condition for allowance and, thus, passage of the application to issuance is courteously solicited.

In re Appln. of Nie et al.
Serial No. 09/405,653

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Salim A. Hasan', is written over a horizontal line.

Salim A. Hasan, Registration No. 38,175

One of the Attorneys for Applicant(s)

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Two Prudential Plaza, Suite 4900

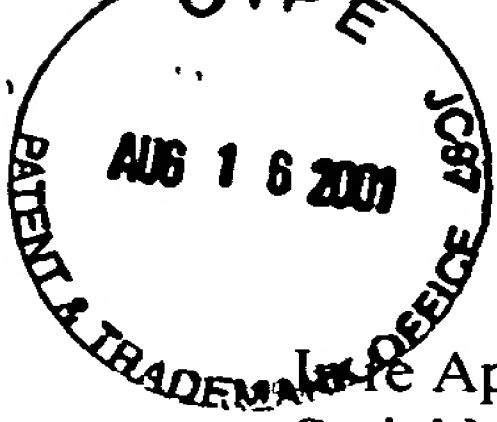
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Date: August 14, 2001



In re Appln. of Nie et al.
Serial No. 09/405,653

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CERTIFICATE OF FACSIMILE TRANSMISSION

The undersigned hereby certifies that the following documents:

1. Response to Office Action (2 pages);
2. Copy of Response to Restriction Requirement (4 pages);
3. Certificate of Facsimile Transmission (1 page);
4. Facsimile Cover Sheet (1 page); and
5. Copy of Post Card that Accompanied Response to Restriction Requirement (1 page),

are being transmitted by facsimile and U.S. mail to the United States Patent and Trademark

Office, Attention: Examiner Christopher L. Chin, Group 1641, Facsimile Number (703) 308-

4242 on the date indicated.

Date:

August 14, 2001 Debra L. Hall



PATENT
Attorney Docket No. 202406

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Nie et al.

Group Art Unit: 1641

Application No. 09/405,653

Filed: September 24, 1999

For: WATER-SOLUBLE LUMINESCENT
QUANTUM DOTS AND
BIOMOLECULAR CONJUGATES
THEREOF AND RELATED
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AUG 20 2001

Examiner: K. Pham, Ph.D. TECH CENTER 1000/2900

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated April 24, 2001, please consider the following remarks.

REMARKS

Summary of the Restriction Requirement

The Office sets forth a restriction requirement between Group I (claims 1-23), which is directed to a water soluble luminescent quantum dot, and classified in Class 257, subclass 40; and Group II (claims 38-39), drawn to a method of making a water soluble luminescent quantum dot, and classified in class 438, subclass 758.

Election with Traverse

Applicants hereby elect, with traverse, the claims of Group I for examination. In this regard, Applicants respectfully submit that the claims of Group II should be examined with the claims of Group I for the reasons set forth below.

Discussion of Restriction Requirement

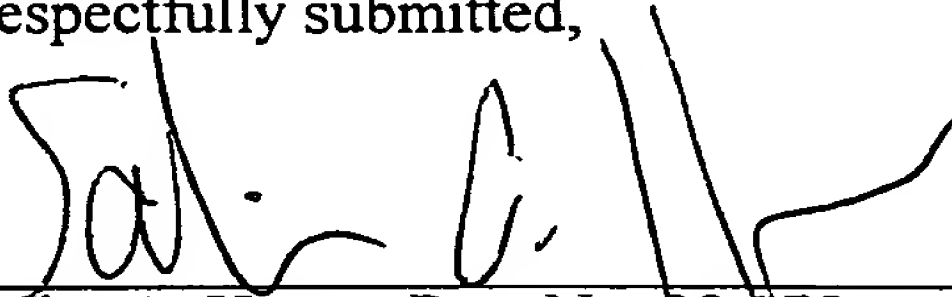
The Office clearly fails to satisfy the requirements for a proper restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*” (emphasis added). As such, both of these criteria must be met for a restriction requirement to be proper. The Office has failed to establish that examination of all of the claims would constitute a serious burden on the examiner if restriction were not required. In this respect, both a search and examination of all of the claims of Groups I and II have been conducted already. Indeed, the Office Action dated September 19, 2000, entailed a substantive examination and search of claims 1-23 and 38-39 (i.e., all of the claims of Groups I and II). Accordingly, there would be no “serious burden” on the Examiner to search and examine the claims of Groups I and II together, as evidenced by the fact that such search and first examination have been done already.

Therefore, in the instant case, the restriction requirement is not proper. As such, Applicant respectfully requests the withdrawal of the restriction requirement and consideration of the claims of Group II, in addition to those of elected Group I.

Conclusion

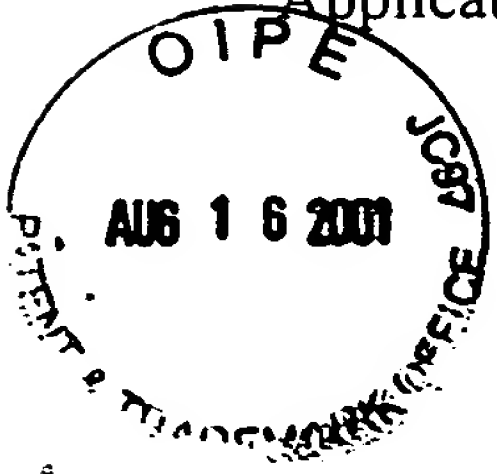
The application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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May 8, 2001



CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: May 8, 2001

Debbie Hall